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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,516	05/01/2002	Dan L. Eaton	10466/301	8121

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EXAMINER

SAOUD, CHRISTINE J

ART UNIT

PAPER NUMBER

1647

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/063,516	<b>Applicant(s)</b> EATON ET AL.	
	<b>Examiner</b> Christine J. Saoud	<b>Art Unit</b> 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/10/02</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: the Tables (at least Tables 1, 6 and the Table beginning at page 141) presented in the instant specification do not comply with 37 CFR 1.58(c) because the font size does not meet the minimum requirements.

Appropriate correction is required.

### ***Claim Rejections - 35 USC §§ 101/112***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

The claims are drawn to a polypeptide. The specification asserts a number of utilities for both the polypeptide and encoding polynucleotide, however, these utilities are not specific and substantial or well established. For example, in Example 11 (page 134), it is asserted that the polypeptide may be used as an antigen to make antibodies.

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Because neither the physiological nor the clinical significance of the polypeptide is known, and because the prior art does not support a very close structural relationship to a well described family of known proteins by both structure and function, the polypeptide does not have utility as required by 35 USC 101. If the polypeptide antigen does not have utility, then the antibody which binds it (or method of making the antibody) does not have a specific and substantial utility.

Another example of utility is in drug screening and rational drug design (Examples 12 and 13, respectively). The methods involve screening for "agents which can affect a PRO polypeptide-associated disease or disorder" (p. 135, paragraph [0507]). No disease or disorder is known to be associated with the claimed polypeptide or the encoding polynucleotide. In order to discern a utility for the claimed polypeptide through drug screening in the absence of guidance about which type of disease or disorder the polypeptide causes or how its involvement could lead to treatment, screening for drugs by using the polypeptide would still require further and undue experimentation to determine the significance of an agent that somehow influenced the polypeptide's function.

Another possible utility comes for the finding that the encoding polynucleotide is "more highly expressed" in "normal" lung as compared to lung tumor tissue (Example 18 at pages 140-141). There is no guidance on how to use this information. No levels (relative or absolute) are disclosed. This information is too sparse to allow the encoding polynucleotide to be used as a diagnostic marker for lung tumors. Further, even if the polynucleotide had utility as a tumor marker, the encoded polypeptide has no such utility

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since there is no reason to suspect that there is alteration of polypeptide sequence or amount in lung tumors *versus* normal tissue. It is not known what the protein does or if the level of the protein of SEQ ID NO:12 in lung tissue corresponds to nucleic acid transcript level, *i.e.*, if decreased gene amplification in tumors corresponds to a decrease in amount of expressed protein.

For these reasons, there is no substantial and specific utility for the claimed polypeptide.

Claims 1-13 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

It would require significant further experimentation to be able to use the claimed polypeptide because no definite function or directly associated disease has been determined for the protein of SEQ ID NO:12, and there is no definite function supported by the prior art. No function can be reasonably assigned based on its homology to another protein(s). Using the claimed protein would require undue experimentation.

Claims 1-5, 9-10, 12-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to polypeptides having at least 80%, 85%, 90%, 95% or 99% sequence identity with a particular disclosed sequence. The claims do not require that the polypeptide possess any particular biological activity, nor any particular conserved structure, or other disclosed distinguishing feature. Thus, the claims are drawn to a genus of polypeptides that is defined only by sequence identity.

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is a partial structure in the form of a recitation of percent identity. There is not even identification of any particular portion of the structure that must be conserved. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus. Which polypeptides of the genus comprising the required sequence are part of the invention has not been set forth.

Other claims are drawn to the extracellular domain of the polypeptide of SEQ ID NO:12 (with or without its signal sequence), even though no extracellular domain has been described. While a signal peptide was identified as amino acids 1-20 of SEQ ID NO:12, the specification does not provide information about if the protein is transported

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to/through the cell's membrane. Therefore, an extracellular domain has not been described.

*Vas-Cath Inc. v. Mahurkar*, 19USPQ2d 1111, clearly states "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only the isolated polypeptide comprising the sequence set forth in SEQ ID NO: 12 (or the encoded polypeptide of the cDNA deposited under ATCC 209788) with or without its signal sequence, but not the full breadth of the claims,

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meets the written description provision of 35 U.S.C. § 112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. § 112 is severable from its enablement provision (see page 1115).

***Claim Rejections - 35 USC § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 9-10, 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because of the recitation of "extracellular domain".

There has been no extracellular domain identified. While a signal peptide was identified as amino acids 1-20 of SEQ ID NO:12, it is unclear where the signal sequence causes the protein to be transported. Accordingly, the limitation that the claimed polypeptide is "the extracellular domain" is indefinite.

***35 U.S.C. § 102***

The following rejections under 35 U.S.C. § 102 is made under the assumption that the effective filing date for the instantly claimed invention is 05/01/2002, which is the actual filing date of the instant application. Applicant is advised that the instant application can only receive benefit under 35 U.S.C. §120 from an earlier application which meets the requirements of 35 U.S.C. § 112, first paragraph, with respect to the



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new claimed invention. Because the instant application does *not* meet the requirements of 35 U.S.C. § 112, first paragraph, for the reasons given above and it is a continuing application of Serial Number 10/006,867, the prior application also does not meet those requirements for the claimed invention and, therefore, is unavailable under 35 U.S.C. § 120.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/16318.

WO 01/16318 teaches the polypeptide of SEQ ID NO:12, which is 100% identical to SEQ ID NO:12 of the instant application. WO 01/16318 also teaches chimeric molecules comprising the claimed polypeptide fused to a heterologous polypeptide wherein the heterologous polypeptide is an epitope tag or an Fc region of an immunoglobulin (see page 6, lines 4-7). Therefore, the instant claims are anticipated by the prior art.

***Conclusion***

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine J. Saoud whose telephone number is 571-272-0891. The examiner can normally be reached on mttr, 8:00-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHRISTINE J. SAOUD  
PRIMARY EXAMINER

*Christine J. Saoud*